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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,653	12/31/2003	Heui Bom Lee	11037-156-999	1611
24341	7590	11/03/2005	EXAMINER	
MORGAN, LEWIS & BOCKIUS, LLP. 2 PALO ALTO SQUARE 3000 EL CAMINO REAL PALO ALTO, CA 94306			MUSSEY, BARBARA J	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,653

Applicant(s)

LEE ET AL.

Examiner

Barbara J. Musser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 6-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/31/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the election of group I in the reply filed on 10/14/05 is acknowledged. The traversal is on the ground(s) that searching both groups would not present an undue burden. This is not found persuasive because, as the restriction indicated, the two groups have a different classification which would require different fields of search for the method and article.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Herring, Jr. et al.(U.S. Patent 5,470,416).

Herring, Jr. et al. discloses an inner panel(11) and an outer panel having a flange portion(13), applying a hemming sealer(17) to an interior portion of the flange portion, positioning the inner panel at the flange portion and pressing it there, and folding the flange portion so as to form a hem wherein beads within the adhesive create a gap of a predetermined clearance between the inner panel and the outer panel.(Figures 5-8; Col. 1, ll. 63-65; Col. 2, ll. 57-60)

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Regarding claim 2, since the entire adhesive contains the beads, the gap would extend along the entire edge of the outer panel having the flange portion.

Regarding claim 4, the beads located within the adhesive are considered to interconnect the inner and outer panels since they touch both the inner than outer panels.(Figure 7)

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as being anticipated by Bissonnette(U.S. Patent 6,523,244).

Bissonnette discloses an inner panel(12) and an outer panel having a flange portion(14), applying a hemming sealer(16) to an interior portion of the flange portion, positioning the inner panel at the flange portion and pressing it there, and folding the flange portion so as to form a hem.(Figures 1-5) The adhesive can be a double sided foam tape.(Col. 21, ll. 45) One in the art would understand that such a tape would have a predetermined thickness which would be greater than zero, thus forming a gap between the inner and outer panels which is greater than zero.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herring, Jr. et al. as applied to claim 1 in paragraph 3 above.

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Herring, Jr. et al. discloses as claimed above, and that the beads within the adhesive are 0.076-0.7 mm thick.(Col. 3, ll. 26-27) It would have been obvious to one of ordinary skill in the art at the time the invention was made to choose any bead thickness within the range specified by the reference such as 0.4-0.6 mm since the entire range is taught by the reference.

Regarding claim 5, the reference cited above does not disclose applying a phosphate layer or an electrodeposition layer to the formed article. Applying phosphates and electrodeposited layers on automotive panels is well-known and conventional in the automotive arts. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply either a phosphate layer or an electrodeposited layer to the car panels of Herring, Jr. et al. since such layers are well-known and conventional in the automotive arts.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herring, Jr. et al. as applied to claim 1 in paragraph 3 above, and further in view of Sweeney et al.(U.S. Patent 5,487,803).

The references cited above do not disclose a bead which mechanically interlocks the panels together during a compression step. Sweeney et al. discloses that adhesive take time to form a bond and that applying beads between the panels which mechanically interlock the panels would secure them together.(Col. 1, ll. 33-45; Col. 2, ll. 18-25) It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the beads of Sweeney et a. in the adhesive of Herring, Jr. et al. to form a mechanical interlock since this would allow the panels to be moved

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without waiting for the adhesive to cure(Col. 1, ll. 33-45), particularly since Sweeney et al. discloses the beads can be used in combination with an adhesive.(Col. 4, ll. 10-14)

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara J. Musser whose telephone number is (571) 272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dunn can be reached on (571)-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BJM



SAM CHUAN YAO
PRIMARY EXAMINER